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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,889	03/31/2004	Ori Gerstel	100101-000300US	9087
37490 7590 05/21/2009 Trellis Intellectual Property Law Group, PC 1900 EMBARCADERO ROAD SUITE 109 PALO ALTO, CA 94303				
EXAMINER				
ENG, DAVID Y				
ART UNIT		PAPER NUMBER		
2455				
NOTIFICATION DATE		DELIVERY MODE		
05/21/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/815,889

Applicant(s)

GERSTEL ET AL.

Examiner

DAVID Y. ENG

Art Unit

2455

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 21, 22, 24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2-15, 21, 22, 24 and 26-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 2, 16-20, 23 and 25 have been cancelled. The active claims are 1, 2-15, 21, 22, 24 and 26-27 of which claims 1, 21, 22 and 24 are independent claims.

Claim Rejections - 35 USC § 112/ 1st par.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2-15, 21, 22, 24 and 26-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose a network planning tool being used prior to a time of operation of the digital network to define a recommended route as claimed. The planning tool is essential to practice the claimed invention. Without the planning tool, one of ordinary skill in the art would not be able to make and use the invention without undue experiments.

Response

In respond to the Section 112, 1st Rejection, Applicants **agree** in the response filed on 9/29/2008 that Cisco MetroPlanner and various other planning tools available at or about the time of filing the present application were not used for defining a

recommended route at the time of operation of a digital network. Applicants argued that the specification teaches how to use traditional planning tools such as the Cisco MetroPlanner to define a recommended route and then allocating the recommended route at the time of operation of the digital network. However, Applicants fail to and the Examiner is unable to identify the support of how to use the well known tools such as the Cisco MetroPlanner to define a recommended route. Applicants identify page 1-9 of the Cisco MetroPlanner for the support. However, there is no page 1-9 in the Cisco MetroPlanner. The Cisco MetroPlanner is indexed by chapters and sections.

In response to the Examiner's invitation extended on 11/25/2008 to review the copy via PAIR and to identify the chapter, the sections and subsections therein, Applicant stated that the Cisco MetroPlanner also includes white-colored page number shown in black boxes in the lower left-hand side or lower right-hand side of the pages. The Examiner is unable to find such black boxes in both corners of the pages. The Examiner does find the bullet "Routing Strategy". Applicants rely on the description in "Routing Strategy" for the teaching of a network planning tool for defining a plurality of recommended routes prior to a time of operation of the digital network. However, the description in "Routing Strategy" does not have such teaching. As admitted by Applicants, Cisco MetroPlanner and various other planning tools available at or about the time of filing the present application were not used for defining a recommended route. The specification fails to teach **how to use** the description in "Routing Strategy" to define a recommended route prior to a time of operation of the digital network let alone **a plurality** of recommended routes.

In conclusion, the Cisco MetroPlanner does not teach defining a **plurality** of recommended routes and the specification does not teach **how to use** the Cisco MetroPlanner to define a **plurality** of routes so that a route can be selected from the plurality of recommended routes at the time of operation.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 5-13, 21-22, 24 and 26

Claims 1, 3, 5-13, 21-22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) in view of Applicant's admitted prior art The MetroPlanner™ by Cisco described in [16].

Claim Rejections - 35 USC § 103

Claims 4, 27

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) and Applicant's admitted prior art The MetroPlanner™ by Cisco described in [16] further in view of Moure (USP 7,219,159).

Claim Rejections - 35 USC § 103

Claims 14, 15,

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) and Applicant's admitted prior art The MetroPlanner™ by Cisco described in [16] further in view of Garfinkel (USP 5,408,600).

Details of the rejections have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

Response

Applicants contend that Blouin does not disclose any use of a planning tool prior to a time of operation of the digital network to define a recommended route. The Examiner disagrees. Applicants admit that Blouin is concerned with analysis of routes at a time of operation of the network in order to allocate a new route (line 5, second full paragraph, page 7 of 10 of the response filed on 2/15/2009). In order for Blouin to have the Applicant-admitted capability, defining a plurality of routes prior to the time of operation is required. The tool Blouin used for defining the plurality of routes can be considered as the planning tool. No improvement or inventive concept or unexpected result with respect to the applied references is seen from the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID Y. ENG/
Primary Examiner, Art Unit 2455